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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,491	04/07/2005	Martin Hellsten	PST6366P1US/2187	9838
27624	7590	09/16/2010	EXAMINER	
AKZO NOBEL INC. LEGAL & IP 120 WHITE PLAINS ROAD, SUITE 300 TARRYTOWN, NY 10591			METZMAIER, DANIEL S	
			ART UNIT	PAPER NUMBER
			1796	
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SEP 16 2010

Mailed :

In re Application of : DECISION  
Hellsten et al. : ON  
Serial No. 10/520,491 : PETITION  
Filed: April 7, 2005 :  
For: DRAG-REDUCING AGENT FOR USE IN :  
INJECTION WATER AT OIL RECOVERY :  
:

This is a decision on applicant's PETITION UNDER 37 CFR 1.181, filed August 23, 2010.

A final rejection was mailed on January 8, 2010, which was followed by an after-final amendment submitted on July 7, 2010. The examiner denied entry of the amendment in an advisory action dated July 21, 2010, prompting the instant petition to be timely filed on August 23, 2010. The petition was accompanied by a corrected amendment and is before the Director of Technology Center 1700 for decision.

The petition is **GRANTED** for the reasons below.

## DECISION

As a preliminary matter, it is noted that the July 7, 2010 amendment was held non-compliant by the examiner under 37 CFR 1.121 as including incorrect status identifiers. Applicant has apparently conceded this point by filing a corrected version of the claims on August 23, 2010 along with the instant petition. The August 23, 2010 version differs only by correcting the status identifiers, and was likewise denied entry by the examiner for the same reasons (sans non-compliance under 1.121) as the July 7, 2010 amendment.

Accordingly, to prevent further delay, this petition will be decided with respect to the amendment filed August 23, 2010.

Treatment of after-final amendments is discussed in MPEP 714.13, relevant portions of which state:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection.

The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.

If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search.

In the instant application, the examiner denied entry of the August 23<sup>rd</sup> amendment because:

- 1) "Claim 8 presented two concentration limitations sequentially that appear inconsistent and indefinite."
- 2) "The limitations of claim 8 have not herein before been presented in claim 8."
- 3) "Applicants do not provide a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented."

Considering these in turn, with respect to the sequential concentration limitations of claim 8, it is not entirely clear what the examiner is referencing. It appears the examiner is concerned with the weight percentages being followed by parts per million. A similar format was followed in claim 11, as it stood on September 10, 2009, and the examiner raised no objection to it at the time of the January 8, 2010 final rejection. Therefore, there does not appear to be any new issue to consider with regards to the definiteness of claim 8 which would justify denying entry to the August 23<sup>rd</sup> amendment.

Next, while the limitations added to claim 8 were not previously in that particular claim, they were present in claims 17 and 18, which depended from claim 8. The examiner presumably considered them in the course of examining these dependent claims. Thus their inclusion in claim 8 does not appear to raise any new issues. On the contrary, by incorporating the dependent claims into the independent claim, the issues for appeal are reduced and simplified.

Finally with respect to the last reason given by the examiner, as noted above the proposed amendment would simplify the issues on appeal in this particular case without raising any new issues. As stated in the MPEP above, in such a situation a separate explanation of 'good and sufficient' reasons is generally not required.

As the examiner has not set forth any proper reasons for denying entry of the August 23, 2010 amendment, applicant's petition for entry thereof is **granted**.

10/520,491

The application will be forwarded to the examiner for further consideration of the amendment consistent with this decision.

/W. GARY JONES/  
W. Gary Jones, Director  
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